



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

JESSOP, *et al.*

Serial No.: 09/196,524

Parent Filed: November 20, 1998.

CPA Filed: May 20, 2002

For: **PIPETTE TIP PACKAGING  
AND TRANSFER SYSTEM**

Group Art Unit: 1743

Examiner: HANDY, D.

Atty. File No.: 45825-01012

**CERTIFICATE OF FACSIMILE**

I hereby certify that this correspondence is being sent via express mail  
EV 300738001 US upon Commissioner for Patents P.O. Box 1450,  
Alexandria VA 22313 this 21st day of November, 2003.

**Holme Roberts & Owen LLP**

By Teresa K. Burgon

**AFFIDAVIT OF THOMAS J. ROSSA**

STATE OF UTAH

COUNTY OF SALT LAKE

Thomas J. Rossa, first being duly sworn, deposes and says that

1. He is a resident of Salt Lake County, State of Utah, over the age of 21 and competent to give testimony.
2. He is a duly licensed member of the Utah State Bar and was admitted to practice before all the courts of the State of Utah in 1973 and is still so admitted. He is admitted to practice before the United States Patent and Trademark Office (PTO) and is assigned Registration Number 26,799.

3. He is counsel of record for the Applicants in the above identified patent application.
4. He was personally involved in the preparation and filing of the above identified patent application and its related predecessors.
5. In the furtherance of the above identified patent application, I obtained assistance from an associate, James Farmer, from in or about 2001 through 2002. While Mr. Farmer was assisting, I maintained total responsibility for this application. My secretary, JoAnn Bawden also assisted.
6. To my present information and belief, James Farmer is a registered patent attorney who was first registered and admitted to practice before the PTO in late 2000. He has graduate degrees in mechanical engineering.
7. JoAnn Bawden for all times relevant was and is my secretary and assistant. She has been a legal secretary assisting patent attorneys for over 15 years in my old firm working directly or indirectly for me during most of those years. She moved over to my present firm from my old firm just over 1 1/2 years ago and has been assisting me in connection with patent and trademark matters.
8. To further advance the present application, a preliminary amendment was submitted dated May 20, 2002. It presented some new claims in method format in an effort to deal with the rejections and objections that were being presented. The preliminary amendment was drafted in large part by Mr. Farmer. It was thereafter reviewed and approved for filing by me; and it was filed.

9. To complicate this matter even more, this firm relocated its offices moving to this location on Labor Day weekend, 2002. Starting in July, the impending move introduced considerable turmoil into the office routine that extended past September 2002 well into the Fall of 2002. There was turmoil because of the need to pack belongings and furniture. Firm administration was disrupted and, of course, there was turmoil in the filing system and files of the firm in connection with the move.

10. Having not heard from the PTO based on the absence of an Office Action, a Second Preliminary Amendment dated October 29, 2002 was prepared some by Mr. Farmer and some by me. It was submitted to the PTO and apparently was received by the PTO and was NOT entered as herein after stated.

11. With time now passing into the early part of 2003, I became worried and asked that the staff investigate and find out why we had not received an office action or when we could be expecting one. I directed JoAnn Bawden to call to get the status. The desired telephone call was made to the PTO by Ms. Bawden in March, 2003 at my request. Ms Bawden reported that she had a conversation with the Examiner who informed her that he had received, but not entered, the Second Preliminary Amendment. Rather, he reported that the Office Action of July 2, 2002 had been issued. Ms. Bawden had the file in front of her. She looked for the Office Action of July 2, 2002 and could not find it in the file. While the Examiner was on hold, she called me on the intercom and asked me how to proceed. I then instructed her to tell the Examiner that the Office Action of July 2, 2002 was not on hand and apparently had not been received by this office and to ask the Examiner if he would simply reissue the Office Action of July 2, 2002. When he indicated that he would not, she asked me what to do and I told her to ask that a copy of the missing Office Action of July 2, 2002 be made available as soon as possible. In this

conversation, the Examiner informed Ms. Bawden that he would shortly be issuing a Notice of Abandonment. Ms. Bawden then asked the Examiner to supply a copy of the Office Action of July 2, 2002; and he said that he would.

12. The Notice Of Abandonment was mailed on March 19, 2003 and received on March 27, 2003.

13. The requested copy of the Office Action of July 2, 2002 has never been received.

14. While waiting for the requested copy of the Office Action of July 2, 2002, I and Ms. Bawden began a search looking for the missing Office Action on the assumption that it may have been received but misplaced. This search began about April, 2003 and continued into and through May, 2003. Files searched included all the files for MEDAX, Inc. the assignee and client in this case. The inventors were then employed by MEDAX, INC. MEDAX, INC. has a number of other matters with this firm all of which are being handled by me. The files for each of these matters was recovered from storage and searched with no evidence of the missing Office Action. After this search, I was forced to wait for the missing Office Action requested from the Examiner.

15. When the missing Office Action had not been received by the end of July 2003, I again asked my assistant, Ms. Bawden, to follow up on why we had not obtained a copy of the missing Office Action. To my understanding she did not proceed immediately but rather put this on a list of things to do. She was about to make another follow up inquiry, when a copy of the missing office action was found by me.

16. As stated, Mr. Farmer had assisted the undersigned counsel in many patent office matters including this matter. He had prepared drafts of documents submitted to the Patent Office in several cases and supplied them to the undersigned for approval. In this case, he assisted by preparing several of the more recent documents including the Preliminary Amendment of May 20, 2002 presenting claims 10-14.

17. Mr. Farmer left the employ of this firm in February 2003. Just prior to his departure, the undersigned and the associate together went through all of the associate's papers, binders and things in his office that related to any ongoing projects with which he was involved. A list of active matters had been prepared and was reviewed in detail. There were no materials relating to the above identified application or any other MEDAX matters included in those materials or discussed.

18. In September of 2003, an unmarked file was brought up to the desk of the undersigned. It was placed there by an inside office runner who retrieves files from their normal location in a basement storage area; and no runner brings them to staff or attorneys requesting the files. It was brought to me not because I asked for it but because it has materials in it that appeared to have something to do with the patent office. It was sent to me with the idea that I, as the only then existing patent attorney in this office, could determine what it was and if it was of value, to tell the staff where to file it or what to do with it. I did not look at it right away, but had it placed in a pile of incoming materials for action. It may have been as much as a week or ten days before I looked at it. When I did, I found that the totally unmarked file folder contained a black three ring binder that contained a copy of the missing Office Action, the previous office action, an as-filed application and a copy of the primary reference. Where the file had been and how it came to be found is simply unknown.

19. It was an observable habit of Mr. Farmer to assemble pertinent documents relating to a matter upon which he was working into a three ring binder. This in fact was a practice that I myself followed and had used in the mentoring process. Thus, it would appear that Mr. Farmer had prepared this folder.

20. It was also an observed fact that Mr. Farmer had at least once taken incoming mail for action before it was properly docketed or distributed. While he had been asked to not do that, he appears to have done so in this case. It is not known if he was asked to stop removing PTO correspondence and other incoming materials from the mail before or after July, 2002. However, this is exactly the kind of situation which I have worked to avoid and why it is imperative that all incoming mail be processed by the secretary to first attend to docketing.

21. Given that Mr. Farmer was involved in preparing the first draft of everything that had been sent to the PTO in connection with this case in the year or so prior to the arrival of the Office Action of July 2, 2002, it appears that he saw the office action when it arrived at the reception desk. In July of 2002, all incoming mail was delivered to the receptionist at the firm's reception desk. She or he would open the mail and direct it per standing instructions typically to the attorney's secretary. It is apparent that the Office Action of July 2, 2002 was received at this desk because it was date stamped as received on July 9, 2002. However, it appears that the Office Action never made it to Ms. Bawden's desk (per standing instructions) because the original is not in the file. If she would have received the file, she would have sent it to docketing (a separate docketing clerk attends to this function).

22. The undersigned has asked Mr. Farmer what he remembers because he and I have remained in contact. Mr. Farmer reported that he remembered the binder, but he also reported

that he had no memory about the office action in question. The undersigned thus believes that the associate saw the office action in the incoming mail, took it to keep his binder current. I believe, but have nothing to prove, that after he had made his copy, he sent the original back to the secretary by interoffice mail in or about August, 2002. The interoffice mail may have been disrupted, or the item lost after it made its way to the secretary. Alternately, he may have failed to send it back and in turn it could have become mixed into other papers during the packing and moving activity in August 2002.

23. In short, the Office Action of July 2, 2002 was not docketed. In turn I had no way of knowing that it was in existence and that a response was necessary. This is clearly the case because I would never have sent in a Preliminary Amendment in response to an Office Action. I have been practicing for nearly 30 years and know that a Preliminary Amendment would not have been deemed to be legally responsive.

24. Because the Office Action was not docketed, it was not responded to in a timely manner. The original has never been located. The failure to respond was thus unavoidable and certainly unintentional.

25. To my memory, Ms Bawden has never lost an Office Action once it has been received.

26. Even though Mr. Farmer was assisting in this case from time to time, I remained then and am now the responsible attorney for this case.

27. I believe that the delay in responding to the Office Action of July 2, 2002 is administrative and was not intentional. Abandonment was accidental and not the result of a deliberate choice to abandon the application. It was also unavoidable because a younger

associate must have taken mail in violation of office policy which if followed would operate to ensure proper docketing. For whatever reason, he did not follow up to ensure that the action was docketed leading to the ultimate abandonment. There is no way to avoid unauthorized actions of another that are inconsistent with office practice and policy.

  
Thomas J. Rossa

STATE OF UTAH )

) ss.

COUNTY OF Salt Lake )

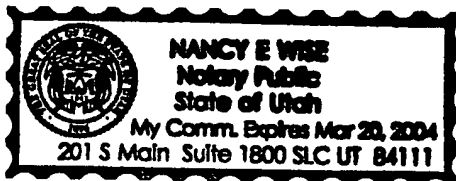
Subscribed and sworn to before me by Thomas J. Rossa on this 21st day of November, 2003.

Witness my hand and official seal.

My commission expires:

March 20, 2004

  
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Notary Public



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